APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,753	06/05/2000	Eric Davison	205236	7824

23460	7590	03/02/2004

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EXAMINER
LIM, KRISNA

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	09/587,753	DAVISON ET AL.
	Examiner	**Art Unit**
	Krisna Lim	2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 December 2003*.

2a)☐ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) *1-11 and 17-21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-16,22,23 and 35* is/are rejected.

7)☒ Claim(s) *24-34* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) ☐ Other: .

1.   Applicant's election with traverse of the invention II, claims 12-16 and 22-

35, in Paper No. 8 is acknowledged. The traversal is on the ground that:

a) the inventions must be independent or distinct as claimed;

b) there must be serious burden on the examiner if restriction is required;

c) before making a restriction requirement after the first action on the merits, the

examiner will consider whether there will be a serious burden if restriction is not

required;

d) an action on the merits was mailed on June 11, 2003, covering claims 1-35,

which includes all claims subjects to the present restriction

This is not found persuasive because as mentioned in the previous office action:

Restriction to one of the following inventions is required under 35 U.S.C.

121:

I.   Claims 1-11, drawn to a computer-readable medium having computer-

executable instructions for performing steps for directing data transfer in a

computer having a plurality of transport modules, the steps comprising: a)

receiving transport specific data from an application; b) determining at

least one of the plurality of transport modules with which the transport

specific data is associated; c) passing the transport specific data to said at

least one of the plurality of transport modules; and d) sending a transport

independent interface to the application, classified in class 719, subclass

311.

II.   Claims 12-16 and 22-35, drawn to a method to send at least one object

between a first device and at least one of a second device comprising the

steps of: a) creating a primary interface; b) finding the at least one of a

second device; c) connecting to the at least one of a second device

through a device interface; and d) commanding one of put command and

a get command to transfer the at least one object between the first device

and the at least one of a second device, classified in class 719, subclass

328.

III.   Claims 17-22, drawn to a method to provide a service to at least one

device, the method comprising the steps of: a) listening for an incoming connection; b)

receiving a service connection interface when an incoming connection is received, the

service connection interface for listening for incoming command requests; c) listening

for incoming command requests from the at least one device; d) receiving a command

structure when an incoming command request is received that describes the incoming

command request; and e) performing one of a read and a write operation in response to

the incoming command request, classified in class 719 , subclass 329.

2.   Inventions I and II are related as subcombinations disclosed as usable together

in a single combination. The subcombinations are distinct from each other if they are

shown to be separately usable. In the instant case, invention I has separate utility such

as a computer-readable medium having computer-executable instructions for

performing steps for directing data transfer in a computer having a plurality of transport

modules that lacks the steps of: a) creating a primary interface; b) finding the at least

one of a second device; c) connecting to the at least one of a second device through a

device interface; and d) commanding one of put command and a get command to

transfer the at least one object between the first device and the at least one of a second

device. See MPEP § 806.05(d).

3.   Inventions I and III are related as subcombinations disclosed as usable together

in a single combination. The subcombinations are distinct from each other if they are

shown to be separately usable. In the instant case, invention I has separate utility such

as a computer-readable medium having computer-executable instructions for

performing steps for directing data transfer in a computer having a plurality of transport

modules that lacks the steps of: a) listening for an incoming connection; b) receiving a

service connection interface when an incoming connection is received, the service

connection interface for listening for incoming command requests; c) listening for

incoming command requests from the at least one device; d) receiving a command

structure when an incoming command request is received that describes the incoming

command request; and e) performing one of a read and a write operation in response to

the incoming command request. See MPEP § 806.05(d).

4.   Inventions II and III are related as subcombinations disclosed as usable together

in a single combination. The subcombinations are distinct from each other if they are

shown to be separately usable. In the instant case, invention II has separate utility such

as a method to send at least one object between a first device and at least one of a

second device that lacks the steps of: a) listening for an incoming connection; b)

receiving a service connection interface when an incoming connection is received, the

service connection interface for listening for incoming command requests; c) listening

for incoming command requests from the at least one device; d) receiving a command

structure when an incoming command request is received that describes the incoming

command request; and e) performing one of a read and a write operation in response to

the incoming command request.   See MPEP § 806.05(d).

5.   These inventions are distinct for the reasons given above, and the search
required for each Group is different and not co-extensive for examination purpose.

6.   For example, the searches for the two inventions would not be co-extensive
because these groups would require different searches on PTO's classification class
and subclass as following:

        (a) The Group I search (claims 1-11) would require use of search class 719,
subclass 311 (which would not required for the groups II and III).

        (b) The Group II search (claims 12-16 and 22-35) would require use of search
class 70, subclass 328 (which would not required for the groups I and III).

        c) The Group III search (claims 17-22) would require use of search class 719,
subclass 329 (which would not require for the groups I and III).

7.   In response to paragraph 1 a) above, those three groups of the invention are
independent and very distinct as claimed. See paragraphs 2-6 for the explanations.

8.   In response to paragraphs 1 b) to d) above, yes, there is a serious burden on the examiner to exam these three inventions in one application. Moreover, applicants are advised to review their response on 9/12/03 (pages 15-17). In that response, the applicants alleged that the examiner did not take or address the steps or elements of claims 12-35 and detailed what they are. And, actually claims 1-11 are the identical claims of the application serial No. 09/552,320 that is the co-pending of this case. Since applicant elected the invention II, claims 12-16 and 22-35, the examiner needs a new search and writes a new rejection.

Therefore the restriction requirement is still deemed proper and it is made Final.

9.   Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10.   The Abstract of the Disclosure is objected to because it should set forth a process for making and/or the use thereof are not obvious that is related to the claimed language. See M.P.E.P. § 608.01(b).

11.   The drawings are objected to under 37 CFR 1.83(a) because they fail to show all the steps and functions of claims 12-16 and 22-35 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid

abandonment of the application. The objection to the drawings will not be held in

abeyance.

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

13.   Claims 12-16 and 22-35 are rejected under 35 U.S.C. § 103(a) as being

unpatentable over Diamond et al. [U.S. Patent No. 6,591,295].

14.   Diamond et al. disclosed (e.g., see Figs. 1-4) the invention substantially as

claimed. Taking claim 12 as an exemplary claim, the reference disclosed a method to

send at least one object (copy and past, drag-and-drop, object's URL is transferred to

another application, col. 3, lines 43-44) between a first device (database) and at least

one of a second device (application, web page, Web base program) comprising the

steps of:

a) creating a primary interface (a clipboard 117);

b) finding the at least one of a second device (first line of Fig. 2)

c) connecting to the at least one of a second device through a device interface

(e.g., a novel interface between Web based programs and a database) ; and

d) commanding one of a put command (225 of Fig 2) and a get command (224 of

Fig. 2) to transfer the at least one object between the first device and the at least one of

a second device (e.g., see col. 5).

15.   Diamond et al. did not explicitly mention as exactly as claimed language. For example, Diamond et al. did not call his clipboard as a primary interface. To the extent of the claimed language, it would have been obvious to one of ordinary skill in the art to recognize that the clipboard 117 would have been some kind of the primary interface because it is in fact a graphical user interface (e.g., see an abstract, clipboard 117 of Fig. 1) that enables a user to view, to copy, to paste, to drag and to drop objects between two devices.

16.   As to claims 13-16, while Diamond et al. disclosed the steps of executing a graphical user interface clipboard program for performing different kinds of functions as the tool necessary for copying, pasting, dragging, dropping, retrieving objects from DB, capturing objects, editing objects, etc., Diamond et al., however, did not explicitly details as claimed such as a command for connecting, putting, getting, enumerating, disconnecting, aborting, setting a path, etc.. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to recognize that such specific commands for specific operations or functions would have been a matter of programming choices.

17.   Claims 22, 23 and 35 are similar in scope as of claims 12-16, and therefore claims 22, 23 and 35 are rejected for the same reasons set forth above for claims 12-16.

18.   Claims 24-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

19.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Krisna Lim whose telephone number is (703) 305-9672. The examiner can normally be reached on Monday-Friday from 7:30 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Mr. Glenton Burgess, can be reached at (703) 305-4772. The fax phone

number for the organization where this application or proceeding is assigned is (703)

872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [glen.burgess@uspto.gov].

All Internet e-mail communication will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirement of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Office Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

KI

February 29, 2004

KRISNA LIM
PRIMARY EXAMINER